

REMARKS

Claims 8-13 and 20-25 are currently pending in this application. In a Final Office Action dated October 8, 2004, the Examiner has rejected claims 8-13 and 20-25.

Claims 8-13 and 20-25 have been rejected pursuant to 35 U.S.C. 112, first paragraph as failing to comply with the description requirement. The rejection is a “new matter” rejection based upon amending the claims to recite particle sizes as “ μm ” instead of “nm.”

Claims 8-13 and 20-25 have been amended to recite particle sizes in “nm” in conformance with the specification. Withdrawal of this rejection is respectfully requested.

Claims 8-13 and 20-25 stand as previously rejected pursuant to 35 U.S.C. 112, second paragraph, as being indefinite. According to the Examiner:

“The recited hydrophilic powder as a conductive oxide powder is indefinite since the nature (or definition) of said hydrophilic powder is nether taught nor defined. Is it water-soluable or water-dispersible or hydrophilic compound coated or treated or hydrolyzable, for example?”

This rejection is again respectfully traversed. It is respectfully urged that the Examiner is improperly manufacturing an artificial ambiguity with respect to the word “hydrophilic” that does not exist in either the specification or the art, and that persons of ordinary skill in the art understand the meaning of the word “hydrophilic” without the need for that word to be defined by applicants, or by anyone else for that matter. The Examiner is not a person of ordinary skill in the art, and the Examiner’s failure to understand the word “hydrophilic” is not evidence that persons skilled in the art do not understand this word or that it is ambiguous.

The Examiner states:

“The specification and claims recites a conductive oxide powder being a hydrophilic powder, however no properties with respect to said hydrophilic powder and none of the conductive oxide powder is disclosed. Applicant failed to describe said hydrophilic powder adequately in the specification since the scope of said conductive oxide powder being also hydrophilic powder is not defined.

It is respectfully urged that the Examiner is incorrect. First of all, the properties of the conductive oxide powder *are* disclosed. The hydrophilic or non-hydrophilic nature of a powder *is itself* a property of the powder. The words hydrophilic and non-hydrophilic are used daily in the art and are thus well understood.

There is no evidence that persons who use this term in the art do not know what it means or are compelled to explain it each time it is used. The New Oxford American Dictionary defines “hydrophilic” as: “having a tendency to mix with, dissolve in, or be wetted by water. The opposite of hydrophobic.” There is no evidence in the specification that the inventors intended a different meaning for the word “hydrophilic.” The Examiner has presented no reason at all why the common ordinary meaning of this word should not control.

In this respect, the question asked by the Examiner (quoted above) -- “Is it water-soluble or water-dispersible or hydrophilic compound coated or treated or hydrolyzable, for example?” -- is both unnecessary and irrelevant. First, the question is in part inquiring about a definition of the word “hydrophilic.” This question is adequately answered by the definitions quoted herein. It is assumed that these definitions are known to and understood by persons of ordinary skill in the art. If the Examiner contends otherwise, applicant hereby demands that the Examiner support the assertion that persons of ordinary skill in the relevant art do not either use or understand the definition of “hydrophilic”

The Examiner's question is also in part asking how the compound becomes hydrophilic ("or hydrophilic compound coated or treated"), It is respectfully urged that this inquiry is irrelevant. How a substance becomes hydrophilic (e.g., by being hydrophilic compound coated or treated as queried by the Examiner) does not affect the definition of whether or not the substance *is* hydrophilic or not. As long as the substance *is* hydrophilic, it does not matter how the substance became hydrophilic.

In this respect applicants teach in the specification (at p. 5, lines 8-11) that "[t]he conductive oxide powder may also undergo various surface processing, for example, hydrophilic processing or non-hydrophilic processing, wherein the combination of solvents used must be appropriately selected, as described below, depending on the surface treatment conditions."

This is a clear teaching by applicants that the oxide powder may be rendered hydrophilic or non-hydrophilic by surface treatment as desired. Thus, it is not surprising or inconsistent that the specification includes an example referred to by the Examiner wherein the ATO powder is non-hydrophilic (see p. 8, line 26). The Examiner has not urged that such treatments are unknown in the art. It is respectfully urged that this teaching supports the use in the claims of a non-hydrophilic ATO compound.


In addition, as admitted by the Examiner, the NGT Corporation article teaches that oxides of metals are hydrophilic. Thus, it is elementary that ATO will remain hydrophilic if it is not surface treated to render it non-hydrophilic as taught in the specification. It is respectfully asserted that instead of realizing that the non-hydrophilic ATO mentioned in the example has become non-hydrophilic by surface treatment as taught in the specification, the Examiner is incorrectly assuming that the word "hydrophilic" is ambiguous. It is urged that this cannot be a reasonable reading of the specification as would be made by a person of ordinary skill in the art.

With respect to the prior-art rejections, claim 20 has been amended to include the limitations of claim 22. Claim 22 was not rejected over any prior art reference or combination of references. Thus, the amendment to claim 20 overcomes the prior art rejections to claims 20 and 21, 22, 23, 24, and 25, which depend from claim 20.

It is urged that this Amendment places this application into condition for allowance. The Amendments to the claims remove the new matter rejection. If the Examiner still persists in maintaining his rejection based upon the word "hydrophilic" this amendment places this case into better condition for appeal by making applicants position more clear.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'Kenneth D'Alessandro', written over the printed name.

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Dated: January 6, 2005

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